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In re Application of	:	
LAN, Xuekui, et al.	:	
U.S. Application No.: 09/763,214	:	DECISION ON PETITION TO
Attorney's Docket No.: VALMET-5210	:	REVIVE ABANDONED
For: METHOD AND APPARATUS FOR THE	:	APPLICATION UNDER
HIGH SPEED APPLICATION OF	:	37 CFR 1.137(b)
COATING TO A TRAVELING PAPER	:	
WEB	:	

This decision is issued in response to applicants' "Petition For Revival Of An Application For Patent Abandoned Unintentionally Under 37 CFR 1.137(b)" filed on 02 February 2001. Applicants have paid the required petition fee.

BACKGROUND

International application PCT/US97/17417 became abandoned under 35 U.S.C. 371(d) at midnight on 30 December 1999 (thirty months after the priority date) for failure to pay the basic national fee.

On 02 February 2001, applicants filed the present application under 35 U.S.C. 111(a) as a continuation of international application PCT/US97/17417, and the petition to revive international application PCT/US97/17417 considered herein. The petition to revive was filed for the purpose of establishing continuity between the international application and the present continuation application.

DISCUSSION

37 CFR 1.137(b) permits the filing of a petition to revive an abandoned application where the abandonment resulted from an unintentional delay. A grantable petition under this section must include: (1) the required reply, unless previously filed; (2) the petition fee required by law; (3) a statement that the "entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional;" and (4) any terminal disclaimer and fee required pursuant to 37 CFR 1.137(c). Here, applicants have satisfied items (1) and (2), and item (4) is not applicable. However, applicants have failed to satisfy item (3).

Regarding item (1), the "required reply," section 711.03(c) of the Manual of Patent Examining Procedures states that:

[g]enerally, the required reply is the reply sufficient to have avoided abandonment, had such reply been timely filed.

Here, the filing of the present continuing application under 35 U.S.C. 111 is accepted as the appropriate response under 37 CFR 1.137(b). See MPEP § 711.03(c).. Accordingly, applicants have submitted the "required reply." Item (1) is satisfied.

Item (2) is the required petition fee. The Petition For Revival was accompanied by payment of the \$1,240 petition fee. Item (2) is satisfied.

As for item (3), the petition states that "the entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional," as required. However, applicants have also submitted a "Detailed Statement of How Delay in Discovering the Abandoned Status Occurred" (hereinafter "Statement"). The Statement is incomplete in that it refers to a number of exhibits, none of which are present in the application file. In addition, the Statement raises issues regarding the intent of applicants in abandoning this application with respect to the United States. Specifically, it states that, in December 1999, James Lowe (the attorney identified in the Statement as being responsible for this application during the relevant time period):

contacted a European associate and instructed the associate to enter the national phase in Europe. Mr Lowe allowed the U.S. international phase application to become abandoned through failure to enter the national stage.

Present counsel goes on to state that "I have spoken to Mr. Lowe and he was unaware of the need to enter the United States national phase to prevent abandonment of the pending U.S. application." However, since Mr. Lowe evidently was aware of the need to timely file the national stage application in Europe, and clearly had an adequate docketing system in place with respect to this application, his failure to initiate a national stage in the United States raises an issue as to whether or not the failure to enter the national stage in the United States was intentional. To resolve this issue, applicants must submit a statement from Mr. Lowe explaining in more detail his failure to timely enter the national stage in the United States. Applicants must also submit the exhibits referred to in the present Statement which, as noted above, are not present in the application file. Based on the above, the present petition does not satisfy item (3) of a grantable petition under 37 CFR 1.137(b).

Under the terms of 37 CFR 1.137(c), the terminal disclaimer listed as item (4) above is not required for this application.

Applicants have not satisfied all the requirements for a grantable petition under 37 CFR 1.137(b). The Petition For Revival must be dismissed.

CONCLUSION

The Petition For Revival is **DISMISSED** without prejudice.


If reconsideration on the merits of this petition is desired, a proper reply must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(b)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office



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